

REMARKS

I. Status of the Claims

Claims 29 to 32, 34, 36 and 37 are now pending.

Applicants respectfully submit that no new matter has been added by virtue of this amendment.

II. Claim Rejections- 35 U.S.C. § 103

In the Office Action, the Examiner maintained the rejection of claims 29 to 32, 34, 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Yue et al. (WO/2002/026982) in view of Ruben et al (U.S. Patent No. 7,169,565).

As explained by the Applicants and acknowledged by the Examiner, the Yue reference does not teach a sample from a subject comprising blood serum or plasma. Therefore the Yue reference cannot show or teach "A method of diagnosing cancer comprising detecting human C20orf102 protein present in blood, serum or plasma" as recited in claim 29 or "A method of diagnosing cancer comprising the steps of: (a) collecting blood, serum or plasma from a subject; and (b) detecting human C20orf102 protein contained in the collected sample" as recited in claim 34.

In an attempt to overcome this deficiency, the Examiner combines the Yue reference with the teachings of the Ruben patent. However, one of skill in the art would not look to combine the teachings of the Yue reference with the Ruben patent for the reasons explained below.

In explaining his rationale for once again rejecting the present application over the Yue reference in view of the Ruben patent, the Examiner states on page 4 of the Office Action that the Yue reference "can comprise a bodily fluid". This statement is misleading. What Yue actually states is:

The term "sample" is used in its broadest sense. A sample suspected of containing SECP, nucleic acids encoding SECP, or fragments thereof **may** comprise a bodily fluid; an extract from a cell, chromosome, organelle, or membrane isolated from a cell; a cell; genomic DNA, RNA, or cDNA, in solution or bound to a substrate; a tissue; a tissue print; etc.

From this paragraph, one of skill in the art would understand that not every SECP listed in the Yue reference is contained in a bodily fluid. Bodily fluid is one of a laundry list of possible samples.

Further, and as previously explained by Applicants, one of skill in the art reviewing the Yue reference would also understand that Seq. ID No:3 is anchored on a cell surface. Specifically, the Yue reference alleges that the molecule of SEQ ID NO:3 (polypeptide) has 51% local homology with a mouse transmembrane protein (GenBank ID g7259265). Indeed, pages 83-85 of the Yue reference disclose assays for "SECP" activity measuring the expression of SECP on the cell surface. One of skill in the viewing the Yue reference would naturally assume from the above that the C20orf102 protein would be anchored on a cell surface.

The Examiner argues that that the Yue reference does teach that the C20orf102 protein is not anchored, but his only support is based on the improper combination of the Yue reference with the teaching of the **present** invention. Specifically, on page 6 of the present Office Action, the Examiner states:

Yue et al. disclose the SEQ ID NO:3 (which is 100% identical to the amino acid sequence SEQ ID NO:66 identified as C20orf102 in the instant application) contains a signal peptide which mediates protein transportation or secretion (see p.33, lines 12-15). The **instant specification discloses** on page 50 (see 1st paragraph) that the secretory signal of C20orf102 protein corresponds to 1 to 24 amino acids in the amino acid sequence represented by SEQ ID NO:66. This would suggest that "SECP-3" identified (sic) in Yue et al as SEQ ID NO:3 is the same secreted protein (not anchored) as disclosed in the instant application as C20orf102 (SEQ ID NO:66)

Thus, the Examiner uses the disclosure of the present invention to conclude that C20orf102 of the Yue reference is not anchored. As noted in MPEP § 2145, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin, 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (CCPA 1971). As the Examiner's knowledge in this instance was gleaned from Applicants' disclosure, the reconstruction is improper use of hindsight reasoning.

The Ruben reference is only cited by the Examiner for its disclosure of general techniques for detecting polypeptides in biological analytes. However, the Ruben reference **only** contemplates a technique for detecting polypeptides located in a biological analyte and does not teach or suggest a technique for detecting polypeptides that are anchored on a cell surface. Therefore, one of skill would have no reason to combine the Ruben reference, which deals only with externally secreted proteins, with the cell anchored protein of the Yue reference.

In view of the above, the claimed invention is not obvious from Yue et al. in view of Ruben et al. Withdrawal of the rejection to claims 29 to 32, 34, 36 and 37 under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

This Response is being submitted in response to the Office Action dated October 28, 2010 in the above-identified application. This Response is being submitted together with a petition for three-month extension of time and the fee due under 37 C.F.R. § 1.17(a)(3). If it is determined that any additional fee is due in connection with this filing, the Commissioner is authorized to charge said fees to Deposit Account No. 50-0552.

An early and favorable action on the merits is earnestly solicited. According to currently recommended Patent Office policy, the Examiner is requested to contact the undersigned in the event that a telephonic interview will advance the prosecution of this application.

Respectfully submitted,
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